

In the Amendment and Reply filed January 13, 2004, in response to the Requirement for Information Under 37 CFR 1.105, Applicant stated that the date of first sale of 'Bernini' took place in October, 1997, in The Netherlands. Further investigations by the inventor revealed that 'Bernini' plant material was not first sold in 1997. These investigations revealed that 'Bernini' plant material was provided to a Dutch grower in 1997 solely for the purpose of increasing the amount of 'Bernini' plant material. This grower was obligated by contract not to sell, or make public, the 'Bernini' plant material. Consequently, it was not until 1999, less than one-year prior to the filing date of the 'Bernini' U.S. plant patent application, that 'Bernini' plant material was first made available to the public. Accordingly, the 'Bernini' plant was not made publicly available, anywhere in the world, more than one-year prior to the filing date for the 'Bernini' U.S. plant patent application.

In *In re Wilhelm Elsner*, 2004 U.S. App. LEXIS 16708 (Fed. Cir. 2004), decided together with the companion appeal *In re Keith W. Zary*, 2004 U.S. App. LEXIS 16708 (Fed. Cir. 2004), the United States Court of Appeals for the Federal Circuit (CAFC) held that publication and foreign sale of a claimed plant variety, more than one-year prior to filing a U.S. plant patent application claiming the same variety, *may* bar patenting under 35 U.S.C. §102(b). The CAFC remanded the case to the USPTO for the examiner to consider whether the foreign sales were known to the public and whether the foreign sales permitted asexual propagation of the claimed varieties.

In view of the fact that 'Bernini' plant material was not sold or made publicly available more than one-year prior to filing of the 'Bernini' U.S. plant patent application, and the law articulated in *Elsner*, the cited publications cannot constitute enabling prior art that bars patenting, under 35 U.S.C. §102(b), of a plant patent claim directed to 'Bernini.' Since 'Bernini' plant material was not publicly available more than one-year prior to the 'Bernini' plant patent application filing date, none of the cited publications would have placed the public in possession of 'Bernini' plant material such that the variety could be asexually propagated.

Likewise, the reference to 'Bernini' in the "Aalsmeer Horticultural Sites Fleur Primeur News-New-Novertys" publication dated May 5, 1996, and cited by the examiner in the Official Action mailed March 28, 2001, did not put the public in possession of the new variety. 'Bernini' plant material was exhibited at the Aalsmeer Flower Market in 1996. However, 'Bernini' plant material was not sold or made available to the public in 1996. It was not until commercial quantities of 'Bernini' plant material was available in 1999 that this variety was released to the public. Consequently, none of the prior art publications cited by the examiner could constitute enabling prior art that would bar patenting of a claim to 'Bernini' because none of these publications put the public in possession of asexually reproducible 'Bernini' plant material.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should an improper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Reply Under 37 C.F.R. § 1.111

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Respectfully submitted,

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